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EXAMINER

LUBY, MATTHEW D

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/877,188

Applicant(s)

FECTEAU ET AL.

Examiner

Matt Luby

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/472,134.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed "front suspension being one of an A-arm suspension system and a trailing arm suspension system" (claims 109-117) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 109-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants' disclosure lacks support for the front suspension system being "one of an A-arm suspension system and a trailing arm suspension system."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21, 24, 26-47, 50, 77-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art, hereafter, AAPA, in view of Yoshioka et al. (5,474,146).

AAPA discloses a snowmobile (110) comprising a frame (Figure 1) having a straddle-type, singular seat (Figure 1), first, second and third seat positions on a singular defined by the seat (e.g., a first spot and second spot on the seat), an engine (Figure 1), a drive track (120), a forward-most drive axle (144), two skis (116), and a steering device (e.g., the entire steering unit of 110) having a steering position (a spot on the steering device, 132) disposed forward of the forward-most drive track (see Figure 1), a steering shaft (136) wherein the first seat position is disposed about 565 mm behind the forward most drive axle, the second seat position is disposed behind the first seat position by about 340 or 290 mm, the third seat position is disposed behind the second seat position by about 310 or 345 mm, the steering position is disposed forward of the forward-most drive axle by about 65mm and the frame is between 1493 and 1913 mm long (see Figures 1 and Figure 8 describing various measured distances on a conventional snowmobile). AAPA does not specifically disclose that the angle of the steering shaft is 33° from the vertical. Yoshioka et al. discloses that the angle of the

steering shaft of a snowmobile is 33° from the vertical (Figure 1 and column 18, lines 9-15) in order to construct a design for a steering shaft of a snowmobile incorporating a preferred angle for the steering shaft (inherent benefit – which is that the angle is preferred so the design must necessarily incorporate that angle). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a steering shaft having an angle of 33° from the vertical on the AAPA snowmobile as taught by Yoshioka et al. in order to construct a preferred snowmobile design.

It is noted that since it has been held that discovering an optimum value of a result effective variable (for example an optimum angle of a steering shaft, various seat positions as measured from a forward-most drive axle or a distance between a steering position and a forward-most drive axle) involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claims 109, 110 and 113-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Yoshioka et al. as applied to claims 1, 26, 77, 84, 92, 100 and 104 (respectively) above, and further in view of Imai et al. (4,804,198).

The modified AAPA snowmobile discloses all of Applicants' claimed invention except that for a front suspension system connecting the two skis to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system. Imai et al. disclose a front suspension connecting the two skis (10, 10') to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system (col. 7, lines 62-68) in order to provide an increased spring rate of the outside ski during cornering maneuvers to thereby decrease

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the sway of the vehicle due to centrifugal force (col. 1, lines 13-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a front suspension system connecting the two skis to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system on the modified AAPA snowmobile as taught by Imai et al. in order to provide an increased spring rate of the outside ski during cornering maneuvers to thereby decrease the sway of the vehicle due to centrifugal force.

7. Claims 22, 23, 25, 48, 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Yoshioka et al. as applied to claim 1, 14, 26 and 40 (respectively) above, and further in view of Atherley (5,944,380).

The modified AAPA snowmobile discloses all of Applicants' claimed invention except for a second seat section that is removable with a cargo space behind the first seat section and beneath the second seat section. Atherley discloses a seat having first and second seat sections (106 and 104, respectively) with a cargo space (44) beneath the second seat section (see Figure 4, for example) wherein the second seat section is removable (see Figure 7) in order to provide the seat exchangeability. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second removable seat section with a cargo space beneath it on the modified AAPA snowmobile as taught by Atherley in order to provide seat exchangeability.

8. Claims 52-65 and 67-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Yoshioka et al. and Hisatomi (4,502,560).

The AAPA and Yoshioka et al. documents teach all of Applicant's claimed invention (see the previous paragraph - AAPA discloses the tunnel because it discloses a frame that is tunnel-like fitted over the drive track 120) except for a back end of the seat extending behind a rearward-most portion and a support member. (Even though Applicants' disclosure and drawings do not have support for this limitation it will still be addressed.) Hisatomi discloses that back end of a snowmobile seat (23) extends behind a rearward-most portion of the frame (12; see Figure 1) and a support member for the seat (see Figure 1) for design choice purposes (column 3, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a seat that extends behind the frame on the AAPA snowmobile as taught by Hisatomi in order to construct a preferred snowmobile design.

Regarding claims 53-64, the modified AAPA snowmobile does not disclose that the back end of the seat extends behind the frame by about 80 mm, 230 mm, 60 mm or 290 mm. It would have been obvious to modify the modified AAPA snowmobile to have the back end of the seat extends behind the frame 60, 80, 230 or 290 mm since it has been held that discovering an optimum value of a result effective variable (for example an optimum angle of a steering shaft, various seat positions as measured from a forward-most drive axle or a distance between a steering position and a forward-most drive axle) involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claims 111 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Yoshioka et al. and Hisatomi as applied to claims 52 and 67 (respectively) above, and further in view of Imai et al. (4,804,198).

The modified AAPA snowmobile discloses all of Applicants' claimed invention except that for a front suspension system connecting the two skis to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system. Imai et al. disclose a front suspension connecting the two skis (10, 10') to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system (col. 7, lines 62-68) in order to provide an increased spring rate of the outside ski during cornering maneuvers to thereby decrease the sway of the vehicle due to centrifugal force (col. 1, lines 13-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a front suspension system connecting the two skis to the frame wherein the front suspension is one of an A-arm suspension system and a trailing arm suspension system on the modified AAPA snowmobile as taught by Imai et al. in order to provide an increased spring rate of the outside ski during cornering maneuvers to thereby decrease the sway of the vehicle due to centrifugal force.

10. Claims 66 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Yoshioka et al. and Hisatomi as applied to claims 65 and 67 above, and further in view of Atherley (5,944,380).

The modified AAPA snowmobile discloses all of Applicants' claimed invention except for a second seat section that is removable. Atherley discloses a seat having first and



second seat sections (106 and 104, respectively) wherein the second seat section is removable (see Figure 7) in order to provide the seat exchangeability. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second removable seat section on the modified AAPA snowmobile as taught by Atherley in order to provide seat exchangeability.

### ***Response to Arguments***

11. Applicants' arguments filed 2/10/03 have been fully considered but they are not persuasive. (The amendments and arguments regarding the 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections from the previous Office Action are persuasive and have overcome these rejections.)

Applicants argue on page 5, lines 12-18 that "the Examiner has misinterpreted what Applicants have admitted to be prior art", that "the inventors of the present invention defined the term 'seat position' to point out particular positions on the snowmobile that are adapted to function as the seat position for a standard rider" and "They are not random spots on the seat." However, all that the claims require are first, second and third seat positions on a singular defined by the seat. The claims do not require "particular positions on the snowmobile that are adapted to function as the seat position for a standard rider" as asserted in the response.

Applicants further argue in the paragraph bridging pages 5-6 "AAPA does not show a third seat position". Inasmuch, as a "third seat position" has been claimed, it is

Examiner's position that AAPA (Figure 1) shows a third seat position (e.g., a third spot on the seat, which is all that Applicants' claims require).

Applicants even further argue in the first full paragraph on page 6 "the Examiner has misinterpreted AAPA with respect to the 'steering position.'" Applicants have only recited a steering device having a steering position. This is interpreted to mean a spot on the steering device as was explained in the rejection in the last Office Action. If Applicants do not wish the steering position to be interpreted as a random spot on the steering device (as they contend it is not) then it is suggested they provide very specific clarification of where this is located and how it is related dimensionally to other parts of the steering system and snowmobile as a whole.

In response to applicant's argument that there is no suggestion to combine the references (pages 6-7), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes from the references themselves and more specifically the Yoshioka et al. reference as indicated in the rejection above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "particular positions on the snowmobile that are adapted to function as the seat

position for a standard rider" - referring to the first, second and third seat positions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (703) 305-0441. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone numbers

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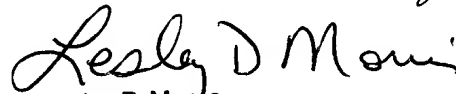
for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Matt Luby  
Examiner  
Art Unit 3611



M.L.  
March 24, 2003



Lesley D. Morris

~~Primary Examiner~~

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